

**REMARKS**

37 C.F.R. § 1.131 Declaration

The February 18, 2009 office action indicates that the evidence submitted with the declaration under 37 C.F.R. § 1.131 on January 14, 2009 is insufficient to establish conception of the subject matter specifically pertaining to binding information and other similar organizational features as recited in the claims. In response, the applicant submits additional evidence regarding the conception of these particular claimed elements and diligence in reducing them to practice.

The applicant submits that the present evidence has only been located within the last three months after an extensive effort to locate additional documentation following receipt of the present office action. The current evidence is related to the product development and provides further support to the previously submitted declaration under 37 C.F.R. § 1.131 by the inventor Dennis Brawn. The applicant further submits that this information was not intentionally withheld from prior submissions or the product of deceptive intent.

Specifically, Exhibit A to the additional Declaration Under 37 CFR § 1.131 of Dennis E. Brawn is a copy of an informational book entitled, "THE IPRO TECH ADVANTAGE" which was released between October 3, 2000 and the middle part of 2001. Exhibit A specifically refers to "[b]inding elements capture & retention", as well as "insertion" of binding element information, "deletion" of binding element information "before or after a copy, with page report and Bates number, auto suffixes". The binding element capture and retention features "avoid reprint of collections". (See item no. 5 of the product capabilities listing on page 2). The informational book also discloses "Folder/document level descriptions", including "Capture & Reporting" of such descriptions. (See item no. 6 of the product capabilities listing on page 2). In addition, the informational book refers to "[b]inding elements slip sheeting on/off selection" (See

item no. 24 of the product capabilities listing on page 2). Exhibit A also describes advantages achieved by capturing the binding element information such that “copies can be recreated – staple per staple, clip per clip, etc.” (See paragraph 6, the third “bullet point” under “Solution Level I: The Laser Print Copy Shop” on page 6) Thus, Exhibit A discloses conception of the claimed binding information and organization features as aspects of the product at least as early as 2001.

Mr. Brawn’s declaration indicates that Exhibit A was released in 2001. Exhibits B and C indicate that this date is accurate. Exhibit B demonstrates that in October 2000, the book of Exhibit A was targeted to be developed as part of the sales and marketing efforts for the 2001 development schedule. (See Marketing item number 3 on page 1 of Exhibit B). Exhibit C evidences the target audience of the informational book, namely Level I shops and Level II service providers which are addressed in the book. (See Sales Team I part b on page 6 of Exhibit C).

The office action of February 18, 2009 rejects claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 as being obvious in view of various references, primarily U.S. Patent No. 6,115,510 to Koga (the “Koga reference”), U.S. Patent No. 6,950,203 to Akabane (the “Akabane reference”), and U.S. Patent Publication No. 2003/0197896 to Doyle (the “Doyle reference”). The office action notes that the Koga and Akabane references fail to disclose a sequence location and a type of the binding element as claimed and cites the Doyle reference as disclosing these elements. The office action also asserts that in light of U.S. Patent Pub. No. 2005/0040642 to Jiang (the “Jiang reference”) it is well known to insert references numbers into electronic images. It is also asserted by the office action that U.S. Patent Pub. No. 2003/0086120 to Murata (the “Murata reference”) teaches that it is well known in the art to store a viewer program on a medium.

However, under 35 U.S.C. §102(e), the date of an anticipating reference is its earliest effective U.S. filing date. In the present case, the Doyle reference was filed on March 20, 2003 and claimed priority to a provisional application filed on March 20,

2002. Similarly, the Jiang reference was filed August 22, 2003 and the Murata reference was filed on October 22, 2002. As demonstrated in both the attached affidavit and the previously submitted affidavit, the applicants conceived of the present invention at least as early as May 15, 2001 as demonstrated by an e-mail communication between inventors discussing the "Kiosk" (now "Copy+") system and THE IPRO TECH ADVANTAGE book released in 2001 providing a product capabilities list of the Kiosk system. The submitted evidence also shows that the applicants diligently developed the system until it was actually reduced to practice in early 2003.

As evidenced by the previously submitted declaration of Dennis Brawn and the additional supporting declaration and evidence included herein, the Doyle, Jiang, and Murata references do not qualify as prior art and therefore may not be used in support of the rejections of the claims. Consequently, the rejections of claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 based on the Doyle reference should be withdrawn. Furthermore, the rejections of claims 8-10, 11, 20-23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 based on the Jiang and Murata references should be withdrawn as unsupported by the references.

#### 35 U.S.C. §103(a) Rejections

Claims 1, 2, 5, 7, 12, 17-19, 24, 27-30, 32, 35, 36, 39, 42-44, 47, 48, 51, 53, 56, 58, 60, 63, 64, 67, 71, 74, 78, 80, and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga reference in view of Akabane reference and the Doyle reference. Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga, Akabane, and Doyle references in view of U.S. Patent No. 5,369,733 to Arimoto. Claims 3, 13, 33, 41, 52, and 76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga, Akabane, and Doyle references in view of U.S. Patent No. 6,965,460 to Gann. Claims 8, 9, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga, Akabane, and Doyle references in further view of the Jiang reference and U.S. Patent No. 5,960,448 to Reichel (the "Reichel reference"). Claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84

stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga, Akabane, and Doyle references in view of the Murata reference. Claims 31, 34, 45, 46, 57, 59, 68, 70, 79, and 81 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koga, Akabane, and Doyle references in view of U.S. Patent No. 5,848,325 (the “Matsumura reference”).

The office action asserts that it would have been obvious to one skilled in the art at the time of the invention to modify the Koga reference in some fashion to arrive at the present claims. However, in light of the Supreme Court decision in *KSR v. Teleflex*, any obviousness determination must be consistent with the traditional *Graham* factors. Thus, obviousness is determined according to (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the prior art and the claimed invention, and (4) the extent of any objective indicia of nonobviousness.

A clear articulation of the reason why the claimed invention would have been obvious is required to support any rejection under 35 U.S.C. § 103. The analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. MPEP § 2143. Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. MPEP § 2142.

In addition, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. In the case of claims 1 and 18, the office action asserts that the Arnaud and Kapeles references teach all of the limitations claimed. To reject a claim based on this rationale, the office action must resolve the *Graham* factual inquiries. Then, the office action must articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the *Graham* factual inquires may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

MPEP 2143(A).

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR v. Teleflex*, 550 U.S. 398, 415-16, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. MPEP 2143(A). In the present case, the office action fails to fulfill several of these criteria with respect to the various claims. Therefore, the applicants respectfully traverse each of the rejections of claims 1-9, 13-24, 26-28 under 35 U.S.C. § 103(a), and because the rejections cannot be sustained, the applicants submit that the rejections should be withdrawn.

The cited references fail to disclose the claimed elements and limitations

The prior art reference when modified still must teach or suggest all the claim limitations of the rejected claim. The 35 U.S.C. § 103 obviousness rejections of these claims are thus inappropriate because one does not arrive at the present invention as recited in the claims by modifying the Koga and Akabane references with the additionally cited references.

The Koga, Akabane, and Doyle references

As discussed in paragraph [0040] of the applicants' specification, binding information is defined as information about binding elements associated with particular documents in a collection or set of documents, such as "paper clips, staples, folders, three-ring binders, boxes, dividers, rubber bands, prong fasteners, and spirals." This binding information is stored for the scanned documents, not for the physical copies as disclosed in the Koga reference. Additionally, as required by amended claims 12 and 24 and as further defined in paragraph [0045] of the applicants' specification, organizational data is stored which comprises "relating the binding information to a sequence location within the set of documents." For example, as discussed in paragraph [0041] of the applicant's specification, the operator is provided the opportunity to "indicate where the relevant binding elements begin and end with respect to the document."

Neither of these limitations is disclosed by either the Koga or the Akabane reference. Furthermore, since the Doyle reference does not qualify as valid prior art, it may not be used to overcome the deficiencies of the Koga and Akabane references. Therefore, since the limitations of independent claims 1, 12, 24, 39, 51, 63, and 74 are not found in the valid references, the rejections of the claims should be withdrawn. Inasmuch as the limitations of the dependent claims depend from and include the limitations of independent claims 1, 12, 24, 39, 51, 63, and 74, the rejections of the dependent claims should be likewise be withdrawn.

The Koga, Akabane, Doyle, and Murata references

The office action asserts that the Koga, Akabane, and Doyle references discloses each of the limitations of claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 except for teaching storing a viewer program on the medium. The office action then states that the Murata reference discloses such a limitation and when viewed in combination with the Koga, Akabane, and Doyle references it would have been obvious to one of ordinary skill in the art to include the feature of storing a viewer program on a medium.

The office action states that Murata teaches “a storage medium that is used to store both image data that is scanned and control data that is a program that allows a user to use the image reader in the system from the personal computer.” In support of this assertion, the office action cites to the “Summary of the Invention” and claims that it discloses an image viewing program. (See ¶¶ [0029]-[0032] of the Murata reference). However, this statement misinterprets the system disclosed by the Murata reference and contrary to the assertion by the office action, the Murata reference discloses a method for obtaining images offline from the digital copying machine by loading a removable storage medium with “read function information.” The removable storage medium is then loaded on a personal computer which has already been preloaded with digital copy machine software. (See ¶¶ [0102] and [0121] of the Murata reference). The “read function information” is then used to save an image from the PC to the medium for later use on the digital copy machine. (See ¶¶ [0123]-[0125] of the Murata reference).

Clearly, this is not a viewer program as claimed and further defined by the applicants’ specification. Rather, the Murata reference discloses nothing more than a way to move an image from a PC to the digital printer. Furthermore, the Murata reference explicitly states that the PC has been preloaded with software compatible with the digital copy machine. Therefore, since all of the limitations of claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 are present, the rejections cannot be supported and should be withdrawn.

The office action fails to provide a showing that one of ordinary skill in the art would have recognized that the results of the combination were predictable

The office action fails to provide a valid motivation or suggestion based on the available cited references that would lead one skilled in the art to arrive at the claimed invention. To support a finding of obviousness, the cited references must expressly or impliedly suggest the claimed invention or the examiner must provide a convincing line of reasoning as to why the claimed invention would have been obvious to one skilled in the art. Reliance upon the knowledge of the person of ordinary skill in the art is not sufficient without that knowledge being instantly and unquestionably demonstrable as

being well-known. MPEP § 2144.03(A). Reliance on such “common knowledge” without greater support is specifically prohibited: “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App & Inter. 1993). “There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. 398, 418 (2007). Further, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* It is important for the office action “to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

The Koga and Akabane references

The office action contends that it would have been obvious to one of skill in the art to modify the Koga reference with the teachings of the Akabane reference for the purpose of saving the physical placement of a binding element on an electronic image to a long term memory. The office action also asserts that there are “a plethora of reasons to combine” the Koga and Akabane references but then fails to identify a single reason except for a passing mention to the references existing in the same field of endeavor.

However, since the Koga reference only discloses saving a location where a staple is to be placed in the sheets output to the bin long enough for a printer to print the pages and attach the staple to the printed documents, a conclusory statement of obviousness fails to demonstrate why one skilled in the art would have combined the Koga and Akabane references. (See Col. 2, lines 13-16, Col. 9, lines 10-22, and Col. 9, lines 45-48 of the Koga reference). The Koga reference clearly states that it is directed at solving the

problem of locating the stapling position for a set of documents outputted from a copier. (See Col. 1, lines 11-23 of the Koga reference).

There is no discussion in the Koga reference to suggest what benefit would be gained by allowing an operator to store the location of a staple in long-term memory. In fact, the Koga reference forecloses the need to store the position of a staple in a long-term memory by presenting the operator with the choice of where to locate a staple prior to beginning the copy process.

The Akabane reference discloses a system directed at reducing the processing burden on a computer by allowing a document prepared on a computer and marked for printing, to be saved in a format that may be printed at a later time without having to re-convert the "page description language" to a format useable by a printer. The office action provides no reason beyond the presence of a "long-term memory" how the teachings of the Akabane reference would lead anyone to incorporate a computer based language format converter with the Koga reference for the predictable outcome of storing the placement of a staple on a set of documents being output from a copier.

The mere fact that a first prior art reference exists which teaches saving a print job to an archive prior to printing and a second prior art reference independently exists which teaches stapling a set of copied documents together does not prove obviousness on its own. The office action relies on an argument that the Koga and Akabane references are in the "same field of endeavor" despite the fact that their respective teachings are only similar in that they involve printing. The Akabane reference is directed at printing preexisting documents from a computer and the Koga reference is directed at a copy machine that is capable of stapling the copied pages together.

Therefore, since the office action fails to "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," the applicants submit that the rejections of the claims are improper and should be withdrawn.

The office action relies on hindsight to support the rejections

The office action's assertion that it would have been "obvious to one having ordinary skill in the art at the time of the invention" is merely a statement of conclusion and the office action provides no articulated reason beyond citing elements why one of ordinary skill in the art would choose to configure a projectile in the manner of the present invention. The applicants submit that, in view of the shortcomings of the cited references, the conclusions of the office action can only be reached through the impermissible use of hindsight. The claimed invention is not simply a "predictable use of prior art elements according to their established functions," and the office action provides no objective reason to combine their respective teachings to arrive at the claimed invention. "A factfinder should be aware ... of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR*, 550 U.S. at 421.

In the present case, the office action relies on the applicants' disclosure and/or hindsight to support the obviousness rejections. The office action asserts that modifying a copy machine that staples a series of printed documents to save the location of the staple on the document to a long term memory would have been obvious at the time the invention was made despite clear shortcomings in each of the cited references. This is clearly inappropriate, as "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP § 2143. Because the office action cannot support the rejection without relying on the applicants' disclosure and/or hindsight, the rejections are improper and should be withdrawn.

Therefore, the applicants respectfully submit that the Koga and Akabane references do not render the claimed invention obvious because they do not disclose all of the limitations of independent claims 1, 12, 24, 39, 51, 63, and 74.

The claimed elements do not merely perform the same functions as they would separately in the cited references, nor do the references provide any motivation to modify the system of the Koga reference with the teachings of the Akabane, Gann, Matsumura,

or Reichek references to arrive at the claimed invention. Furthermore, since the Doyle, Murata, and Jiang references do not qualify as valid prior art references, their teachings may not be used to overcome the deficiencies of the Koga reference. The applicants, therefore, respectfully traverse the rejections and accordingly request that the rejections of the claims be withdrawn.

### **CONCLUSION**

In view of the prior date of invention, the applicants respectfully submit that rejections of claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 are overcome. The applicants therefore respectfully request withdrawal of the rejections to the referenced claims under § 103 and allowance of the same. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

Date: 18 AUG 09



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